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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,298	09/08/2000	Kenneth D. Simone JR.	068520.0110	3516

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Baker Botts LLP
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EXAMINER
PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 December 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10,12 and 14</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) <u>1-10, 12 & 14</u> is/are rejected.

7)☒ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>09/08/2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This communication is in response to Amendment filed 12/21/2005 to claims 1 and 7, claims 1-10, 12, and 14 remain pending.

2.   The terminal disclaimer filed on 12/21/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,850,956 has been reviewed and is accepted. The terminal disclaimer has been recorded.

3.   Applicant's arguments have been carefully considered, however found not persuasive. The substance of submitted arguments have been addressed in detail below.

4.   Quotation of the appropriate paragraphs of 35 U.S.C. 103 that form the basis for the rejections under this section made in this Office action may be found in previous office action.

5.   Claims 1-10, 12 and 14 are rejected under 35 USC 103(a) as being unpatentable over Hollingsworth in view of Ferrel in further view of Belanger (US 6,628,824)

Regarding claim 1, Hollingsworth teaches:

providing a set of predetermined process definitions (see sections 2.1-2.1.1, pages 6-8) including different process activity steps within the process (page 14),

one process definition defining a process for processing data (section 2.1.3 on page 8, sub-processes suited to specific data type see page 19) including image data (section 2.2.1 on page 10);

storing a project definition as executable instances each corresponding to a function definition in the set, executable by workflow engines to perform functions according to the definitions, i.e. workflow logic execution or run-time (section 2.1.1 on page 6, process definition on page 12, project definition see section 2.2.5); the process definition further includes;

a plurality of function components, entities, tasks, activities "portions" which each correspond to one of said function definitions in said set of predetermined function definitions (components that handle/support operations or functions see page 12),

each function definition define interfaces (e.g. one input/output ports) that are functionally related (e.g. output supplies to an input) (Fig. 2 on page 9) according to the corresponding function definition (distribution of information supported by interfaces or points which use communication mechanism for

passing messages between application components see section 2.1.4 on page 8-9, see interfaces definitions on page 9, see import/export interface (i.e. input/output port) section 3.4.2 on pages 28-29);

a "source" component, defining a "data source" and defining an output interface "port" through which said data from the data source can be produced (file store or master source page 17, accessing an object store using a defined an object name and access path via API to internetworking see p. 26-27, API are points of interchange between the workflow components see p. 20-21, see import/export interfaces section 3.4.2 on p. 28);

a "destination" component defining a "destination data" and an input interface "port" through which data from the data source is received (data is distributed across individual components from a source see page 17, see definition interchange wherein a generated output "source portion" of one component is used as on input in another "destination portion", see page 29, Fig. 9);

"binding information" which includes connection between an input and output interface "port" through which data flows between the associated modules or components (data flow between components or products via communication mechanisms section 2.1.3, interfaces role definition see p. 15 data interchange format definition between identified components is defined for each input/output interface Fig. 6, p. 20, language bindings supporting interfaces see p.46)

executing said project definitions (workflow logic) by an engine (see p. 6) or executed by a workflow enactment software (p. 12, see section 3.3.2 p. 22); and

transmitting a communication through a communication mechanism (section 2.1.4), transmitting after processing data during execution of said project definition (Fig. 2 sequential execution of activity steps, interfaces supporting data transmission between the steps p. 9, sequential processing supported by data exchange p. 49); although Hollingsworth teaches the processing of image data in an image processing project definition and object operations including retrieval and setting of object attributes, including processing data between the source and destination component discussed above, it does not explicitly teach adapting, the modifying, assembling image data;

Ferrel teaches "process definition", including a multimedia publishing business system providing a set of predetermined different function definitions (Fig. 1) for providing dynamic online content, said system comprising function components including a function (194) for editing image (Fig. 2, col 10/lines 34-49);

editing said image data during the execution of said function defined for editing said image (col 21/lines 54-61);

automatically transmitting content "a communication" to a remote device (120) through a communication link (e.g. accessible on-line) (col 9/lines 59-67), including create and transmit to a

"remote" device created/edited content (e.g. 120 including a storage device 122) (col 10/lines 16-30), creating process includes image editing (col 10/lines 34-54) after creation published to a distribution point (col 8/lines 61-63, after creation released and stored a publication storage 120, col 9/lines 53-58);

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestion of Hollingsworth of the applicability of his teachings to image processing applicable in other information technology application, the teachings of Ferrel for information distribution including image processing would be readily apparent. One would be motivated to apply the secondary reference's teachings because in doing so, multiple users via the work-list/work-item supported by the plurality of communication protocols taught by Hollingsworth, may have content available for retrieval image data in one of several formats including image data and document data or a combination thereof, wherein the common source library database may store any type of data which can be repeatedly used, as suggested by Ferrel.

Although the applied references teach transmitting a communication after edit said image data, they do not explicitly teach where the condition includes a predetermined number of images.

Belanger teachings in the field of endeavor of automated processing of data, teaching a notification feature including transmitting a communication (col 9/lines 32-42), including transmitting a communication, e.g. a notifying after processing a predetermine number of images data (col 9/lines 22-64).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the teachings of given the suggestions of Hollingsworth for associating image systems with computerized facilitation or automation of business process and IT applications, the teachings of Belanger for information technology particularly images would be readily apparent. One would be motivate to given Hollingsworth means for identifying the state of individual process or activity via specific commands, e.g. query process status for the number of images processed as a percentage from the total number of images on the site or electronic network pending to be processed or the total of predetermined number of image data. One would be motivated to applied Belanger teaches in Ferrel's system enabling the detection of copied images for enforcing owner's copyrights in Ferrel's publishing environment providing information retrieval services, as suggested by Belanger.

Regarding claim 2, transmitting as executing is completed (Hollingsworth: Fig. 2, p. 9)

Regarding claim 3, formatting include formatting an email (Hollingsworth: section 2.2.3, 2.1.4, data conversion see p. 25, email conversion between modules see p. 26, X.400 communication protocol, i.e.

documents the format at the OSI application layer for e-mail messages over various networks transports see section 4.2, Fig. 20 on p. 47)

Regarding claim 4, communication link includes a network (Hollingsworth: section 2.1.4, data transfer between modules is networked)

Regarding claim 5, Internet (Hollingsworth: Internet based management p. 53)

Regarding claim 6, sending communication (Hollingsworth Fig. 2, p. 9)

Regarding claims 7 and 8-10 these claims comprises the computer-readable medium with a computer program, which performs the method of claims 1, and 2, 3, 6, respectively, same rationale of rejection is applicable.

Regarding claim 12, transmitting after processing activity or step (Hollingsworth: Fig. 2, p. 9), processing activity including image editing (Ferrel: transmitting by a publisher a communication, after editing of image to a publication storage col 9/lines 18-25, 52-58); and communication identifies an occurrence of a predetermined condition to initiate a subsequent process (Hollingsworth: Fig. 2, p. 9).

Regarding claim 14, this claim comprises the computer-readable medium with a computer executable program, which performs the method of claim 12, same rationale of rejection is applicable.

Claim Rejection under 35 USC 101

6.   Claims 1 is rejected under 35 U.S.C. § 101 which reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7.   Claim 1 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. In this case, computer-related inventions whether descriptive or functionally descriptive material are non-statutory categories when claimed as descriptive material *per se* (see *Warmerdam, 33 F.3d at 1360 USPQ2d at 1759)*, falling under the "process" category (i.e. inventions at that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) ("The term process means,

art, or method, and includes a new of a known process, machine, manufacture, composition of matter or

material"). Functional descriptive material: "data structures" representing descriptive material *per se* or

computer program representing computer listing *per se* when embodied in a computer-readable media are

still not statutory because they are not capable of causing functional change in the computer.

Response to argument

8.   Regarding claims 1 and 7 rejected as being unpatentable over Hollingsworth in view of Ferrel, it

is argued that, these claims as amended, these overcome the prior art of record. Specifically, where the

Belanger reference does not teach determining a condition including a predetermined number of images,

because according to applicant's interpretation this reference discusses responding to a possible duplicate

image, specifically, after discovering a possible duplicate image, a secondary comparison can be

performed.

In response to the above-mentioned argument, applicant's interpretation of the applied prior art

has been carefully reviewed. Ferrel alone or in combination with Hollingsworth as discuss on claim 1,

teach claim limitation as recited, specifically, automatically transmitting a communication to a remote

device through a communication link after editing said image data during execution of said project

definition, as provided portions cited in response to arguments on previous office action mailed 9/21/05

item number 14 on pages 10-11. Belanger teaches transmitting a communication upon a condition which

includes a predetermined number of images. Specifically,

> A report indicating a possible duplicate image is generated for each located image whose identification information matches within a selected percentage of the reference image identification data 610. A secondary comparison can be performed on any such possible duplicate images located 612. For example, a possible duplicate image can be reloaded to the computer and compared to the reference image using pattern matching, quadrant frequency, usage counts, or any other applicable method. The results of the secondary comparison can then be reported.
>   In one embodiment, the spider or search engine is provided with an alarm or notification feature. Such features can include notifying an operator that an image match has occurred, notifying another party that an image match has occurred, and notifying the addressee of a particular site that an image(s) on that site matches an image(s) on another site. An alarm or notification can be visually displayed by using, for example, a text message, flashing display, color display, different font type or size, shading, borders, graying out, highlighting, animation, audio display, sound alarm, audibly broadcast message, and printed notice.
>   An alarm or notification can be stored for later retrieval, configured to display at particular times, or conditioned upon the occurrence of particular events. For example, the notification can be triggered to display every ten minutes, every time an image match is found, every time ten image matches are found, when no image match is found, to identify the total number of images on a site or electronic network, and to identify the total number or percentage of matching images or sites having matching images.
>   A search for duplicate images can be performed at the direction of user, or can be performed automatically. For example, the user can have a particular image identified and compared to an authenticated image to determine of the images are identical. Alternatively, the search engine or spider can be configured to search for and to determine the selected characteristics of an image or group of images. The spider or search engine can be programmed to locate all images at a particular site, locate images and identify only specific images, locate and identify all images at a particular site, compare located images with a predetermined identified image, and compare located images with each other to identify sites containing identical images. (column 9, lines 22-64).

Arguments that the applied reference does not teach a condition including a predetermined number of images has been considered but not found persuasive.

9.   Regarding claims 1 and 7 are rejected under 35 USC 102(b) as being anticipated by McCubbrey et. al. U.S. Patent No. 4,860,375 (McCubbrey hereafter), applicant states (p. 6 of remarks): "Examiner *agrees* that McCubbrey fails to describe, expressly or inherently, every element as presented in currently amended Claims 1 and 7, and, thus, Applicants respectfully submit that the 102 Rejection based on McCubbrey has been obviated."

In response to the above-mentioned statement, office action mailed 09/21/05 has been carefully reviewed, however such statement is not found.

10.   Regarding claim 1 rejected under 35 USC §101 because the claimed invention is directed to non-statutory subject matter, it is argued [AS BEST UNDERSTOOD] that the "technological arts" test alone is sufficient for patentability.

In response to the above-mentioned argument, in accordance with "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (signed 26 October 2005; Published   in   the   OG   22   November   2005 http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm) this argument is not persuasive.

The "technological arts" consideration is completely absent from recent Federal Circuit case law like State Street and AT&T. Given the current trend in the law, the Musgrave test *should not be considered as current legal* jurisprudence, and should not be used to evaluate process inventions for compliance with Section 101. More important, the Musgrave decision should not be interpreted as imposing a new requirement that certain inventions be in the "technological arts" to be patentable. Instead, Musgrave should be limited to its facts and holding, i.e., that the computer-related invention in dispute was a patentable invention within the meaning of Section 101 because it was an advancement in technology which clearly promoted the useful arts. Thus, the Musgrave decision should not be construed as announcing a new stand-alone "technological arts" test for patentability, but should stand for the proposition that computer-implemented process claims may be patentable subject matter. Furthermore, any attempts to define what is "in the technological arts" raises more questions that it appears to answer. The mere application of an article or a computer does not automatically qualify as eligible subject matter. See, e.g., Benson, 409 U.S. 63, 175 USPQ 673. Thus, this potential analysis improperly focuses on how

the invention is implemented rather than on what is the practical application and the result that is achieved. The emergence of a new patentability requirement that is not firmly rooted in our law also creates significant international concerns. First, the United States is a leader in intellectual property protection and strongly supports patent protection for all subject matter regardless of whether there is a "technical aspect" or the invention is in the "technological arts." The application of a 'technological art' requirement could be used to preclude the patenting of certain inventions not only in the United States, but also in other jurisdictions.

In Ex parte Lundgren, Appeal No. 2003-2088, Application 08/093,516, (Precedential BPAI opinion September 2005), the Board rejected the examiner's argument that Musgrave and Toma created a technological arts test. "We do not believe the court could have been any clearer in rejecting the theory the present examiner now advances in this case." Lundgren, at 8. The Board held that *"there is currently no judicially recognized separate "technological arts" test to determine patent eligible subject matter under Sec. 101." Lundgren at 9.*

Thereby according to the above guidelines the technological arts test alone is not to be used in determining whether a claimed invention is directed to statutory subject matter.

11.   Argument presented by applicant are not persuasive, thereby does not obviated the associated rejection.

12.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.   Accordingly, **THIS ACTION IS MADE FINAL.**   See MPEP § 706.07(a).   Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see http://pair-direct.uspto.gov or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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> (703) 872-9306 (old No. in service until Sept. 15, 2005),
> (571) 273-8300 (New Central Fax No.)

Or Telephone:

> (703) 306-5631 for TC 2100 Customer Service Office.

BEATRIZ PRIETO
PRIMARY EXAMINER